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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,708	01/02/2002	Mitsuo Chihara	011789	5404

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ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP  
1725 K STREET, NW  
SUITE 1000  
WASHINGTON, DC 20006

EXAMINER

AGWUMEZIE, CHARLES C

ART UNIT PAPER NUMBER

3621

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/032,708

Applicant(s)

CHIHARA, MITSUO

Examiner

Charlie C. Agwumezie

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. **Claim 1 and 10** are rejected under 35 U.S.C. 102(b) as being anticipated by Maes et al U.S. Patent 6,016,476.

As per **claim 1**, Maes et al discloses an individual authentication method, comprising the steps of: registering (col. 7, line 20, col. 12, line 55+), together with the personal identification number (col. 7, line 25), personal information relating to the private data of a card owner in a device managed directly or indirectly by the card-issuing institution at the time of issuance of the card (col.7, line 25-30); randomly selecting for each transaction one or more questions from among plurality of questions based on said personal information and requesting the card user to answer said questions upon using the card (col. 8, line 10-25); and verifying the answer contents with the contents of said registered personal information for determining whether the card user is the true card owner(col. 8, lines 25-40, 55-60).

As per **claim 10**, Maes et al discloses an individual authentication system comprising an authentication terminal for the card user to insert a card and input the authentication key for receiving individual authentication upon using the card (See fig. 3, col. 11, line30- 35), and a host computer for conducting authentication of the card user

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upon receiving information from said authentication terminal and returning the authentication results to said authentication terminal (col. 8, line 20-25, col. 12, line 20-25), said individual authentication system further comprising:

A personal information database in which is recorded personal information relating to the private data of the card owner (col. 2, lines 25-30);

A question selection unit for randomly selecting a question to be used for current transaction among the plurality of questions based on the personal information recorded in said personal information database (col. 8, lines 10-25)

A question presentation unit for presenting said selected question to the card user and requesting the answer thereto (col. 8, lines 10-20); and

An answer content determination unit for verifying the answer contents of the card user to said question with the contents of said personal information database and determining whether the card user is the true card owner (see fig. 3; col. 8, lines 35-45, 60-65).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 2-7 and 9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Maes et al in view of Uberti U.S. Patent Application Publication U.S.

2001/0051924.

3. As per claim 2, Maes et al further discloses an individual authentication method, wherein said card is a card issued by a financial institution (col.12, line 60-65) but explicitly failed to disclose that the number of questions selected upon using the card is set to increase pursuant to the increase in the absolute amount of the transaction or in proportion of the transaction amount in the balance in account.

Uberti discloses an individual authentication method, wherein the number of questions selected upon using the card is set to increase pursuant to the increase in the absolute amount of the transaction or in proportion of the transaction amount in the balance in account (see page 6, 0076).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Maes et al and incorporate the ability to increase security in proportion of the transaction amount as taught by Uberti in order to prevent fraud involving large amount of money.

4. As per claim 3, Maes et al further discloses an individual authentication method, wherein the same questions as the questions used upon using the card are used during the personal information registration conducted at the time of issuance of the card (col. 8, Lines 15-20).

5. As per claim 4, Maes et al further discloses an individual authentication method wherein the user may provide the requested answers to the questions but does not explicitly show that the answers are prepared in multiple choice system (col. 8, lines 15-25, 35-40).

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The presenting of training data would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide multiple choice system because such method does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

6. As per claim 5, Maes et al failed to explicitly provide an individual authentication method wherein the plurality of choices to each question includes a choice of no right answer, to indicate that there is no right answer to the question in the choices.

Uberti discloses an individual authentication method wherein the plurality of choices to each question includes a choice of no right answer, to indicate that there is no right answer to the question in the choices ( page 6, 0075).

7. As per claim 6, Maes et al further discloses an individual authentication method wherein on or both of the question and the response thereto is made by voice (col. 8, lines 10-25, 35-40).

8. As per claim 7, Maes et al further discloses an individual authentication method, wherein said card is a card issued by a financial institution (col.12, line 60-65) but explicitly failed to disclose that when the transaction amount is less than a

predetermined amount or when the proportion of the transaction amount in the balance in account is less than a predetermined percentage, personal information is not used as the authentication key and only the personal identification number is used.

Uberti discloses an individual authentication method wherein when the transaction amount is less than a predetermined amount or when the proportion of the transaction amount in the balance in account is less than a predetermined percentage, personal information is not used as the authentication key and only the personal identification number is used (page 6, 0076).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Maes et al and incorporate the ability to low security threshold in proportion of the transaction amount as taught by Uberti in order to increase throughput and decrease transaction time.

9. As per claim 9, Maes et al further discloses an individual authentication method wherein a single question contains a plurality of mutually relating elements of the personal information, so that one meaningful event is represented with the question by combining such plurality of elements (col. 7, line 20-30).

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maes et al in view of Uberti as applied to claim 1 above, and further in view of Houvener U.S. Patent 5,657,389.

As per claim 8, Maes et al further discloses an individual authentication method wherein the database relating to the personal identification number and the database relating to the personal information are provided but explicitly failed to show that the

database relating to the personal identification number and the database relating to the personal information are managed respectively by separate and independent computers, and the information communication between these databases is protected from unauthorized external access.

Houvener discloses an individual authentication method wherein the database relating to the personal identification number and the database relating to the personal information are managed respectively by separate and independent computers, and the information communication between these databases is protected from unauthorized external access See fig. 3; col. 45-50).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Maes et al and incorporate the ability to provide separate and independent databases and computers to manage the personal identification number and the database relating to the personal information as taught by Houvener in order to increase throughput and transaction time while decreasing unauthorized access to both databases.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The reference cited to Uberti U.S. Patent Application Publication U.S. 2003/0046237 is considered relevant to the claimed invention.

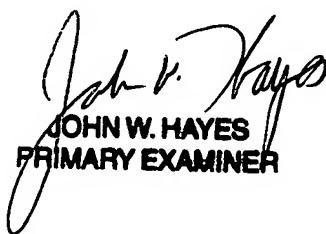
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is (703) 305-0586. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305 – 9768. The fax phone number for the organization where the application or proceeding is assigned is (703) 305-7687.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

acc  
November 5, 2004

  
JOHN W. HAYES  
PRIMARY EXAMINER